UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/865,714	05/29/2001	Ching-Feng Wang	BHT-3111-169	5941

7590 09/26/2006

DOUGHERTY & TROXELL
SUITE 1404
5205 LEESBURG PIKE
FALLS CHURCH, VA 22041

EXAMINER	
PICH, PONNOREAY	
ART UNIT	**PAPER NUMBER**
2135	

DATE MAILED: 09/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/865,714	WANG, CHING-FENG	
	Examiner	Art Unit	
	Ponnoreay Pich	2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 July 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *12 and 13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *12 and 13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *21 May 2001 and 07 July 2006* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims 12-13 are pending. Applicant's amendments have been fully considered, but are moot in view of new rejections presented below in response to the amendments. Any objections or rejections not repeated below for record are withdrawn due to applicant's amendments.

Response to Amendment

Applicant argues that since no Form PTO-948 was received with the prior office action that the except for the proposed drawing corrections, the drawings are accepted as filed. The examiner respectfully directs applicant to MPEP 608.02(b): "In instances where the drawing is such that the prosecution can be carried on without the corrections, applicant is informed of the reasons why the drawing is objected to on Form PTO-948 **or in an examiner's action**...". The PTO-948 form **may** be used by the examiner, but it is not required if the objections to the drawings are noted in the Office action. The drawings were objected to in the prior Office action and remain in objection.

As per the substitute specification, applicant states that a CROSS REFERENCE TO RELATED APPLICATIONS section was not added although an application data sheet has not been filed because the declaration clearly claims benefit to the priority application and it is not believed that the priority application needs to be addressed in the section. The examiner respectfully directs applicant to 37 CFR 1.77(b) which states which sections **should** be included in the specification. Item 2 in the cited rule shows that a Cross-reference to related applications section **should** be included unless such information is already included in the application data sheet.

Applicant argues that the prior art of record, whether viewed separately or combined, does not teach "preventing users not connected to the access device having a serial number from playing the encrypted data, in which in the encrypting step the data is music data and the access device is a personal digital assistant (PDA) or mobile phone having an MP3 playing function for playing the music data". Applicant also argues that the prior art of record, whether viewed separately or combined, does not teach "preventing users not connected to the access device having a serial number from playing the encrypted data, in which the encrypting step the data is an electronic book and the access device is a personal digital assistant (PDA) or mobile phone having an electronic book playing function for playing the contents of the electronic book". The examiner notes that the first argument is directed towards claim 12, while the second is directed towards claim 13. The two arguments are similar, the difference being that the argument for claim 12 is directed towards the access device being used with MP3 data while the argument for claim 13 is directed towards the access device being used to play an electronic book. The examiner respectfully disagrees with both arguments.

First note that in Howard's invention, the serial number of the browser is used as the encryption key to encrypt data sent from the server (paragraphs 42-43). Any data downloaded onto the client on which the limited-use browser is running is prevented from being saved or copied onto any other medium, which prevents redistribution of the data (paragraphs 44 and 49). One skilled should appreciate that if data cannot be copied onto another device, then the data also cannot be played on any other device,

thus users not connected to the device is prevented from playing the data on any other device other than the one it was downloaded to originally, i.e. the device with the serial number. Howard discloses that the client system on which the limit-use browser is running includes a mobile phone (paragraph 33). As the limit-use browser is a software running on the client/mobile phone/access device, the serial number of the limit-use browser is also a serial number of the mobile phone. Howard discloses that the data is audio data and that the access device/mobile phone is able to play the audio data (paragraphs 15 and 40). Audio data being MP3 data is disclosed by Candelore (col 1, lines 23-44). Thus, when viewed in combination, the combination of Howard and Candelore does read on the limitation being argued for claim 12. As per the argument for claim 13, the only difference in argument is that the data format is an electronic book and the access device plays the electronic book rather than MP3 data. As the limit-use browse is capable of displaying text and providing audio output (paragraphs 15 and 49), the mobile phone (paragraph 33) on which the limit-use browser runs is able to display the text of a book or play the audio recording to someone reading a book.

Applicant argues that there is no suggestion in either Howard or Candelore for combining the two teachings. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir.

1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Howard discloses that his limited-use browser plays content just as with a normal web browser, including audio data (paragraphs 15 and 40). Candelore teachings that MP3 was a well known audio format at the time applicant's invention was made. It would have been within knowledge of one skilled in the art to know that MP3 offers near CD quality audio and thus was a popular audio format. One skilled would know that many of the normal web browsers at the time applicant's invention was made supported playback of MP3 file formats because MP3 was a popular audio format, thus because Howard discloses that his limit-use browsers can handle the same formats as normal prior art web browsers, it would have been obvious to one skilled in the art to have Howard's browser also be able to handle MP3 format.

Drawings

The drawings submitted on 7/7/2006 are not accepted as proper substitute drawings because the corrections made are informal and messy. The drawings remain under objections.

Specification

The abstract of the disclosure submitted on 7/7/2006 is objected to because on line 5, "form" should be "from". Correction is required. See MPEP § 608.01(b).

The specification remains objected to for not including a CROSS REFERENCE TO RELATED APPLICATION section, see 37 CFR 1.77(b). All other objections from the prior office action to the specification are withdrawn due to applicant's amendments.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 13 is rejected under 35 U.S.C. 102(e) as being anticipated by Howard et al (US 2002/0069365).

Claim 13:

Howard discloses:

a) Connecting an access device to a subscriber's end of a network (Fig 1 and p3, paragraph 31).

b) Providing a serial number in the access device to the network and using the serial number as an encryption key (p6, paragraph 61 and p7, paragraph 74). *Note that the limited-use browser is software running on the client, thus the serial number of the browser is located in the access device/client.*

c) Encrypting the data on the network to create encrypted data (p6-7, paragraph 69 and p7, paragraph 74).

d) Downloading the encrypted data only to the access device having the serial number (p7, paragraph 74).

e) Preventing users not connected to the access device having the serial number from playing the encrypted data (p4, paragraph 42 and p7, paragraph 74). *One skilled should appreciate that because the data is prevented from being copied or saved to any other device except the device with the limited-use browser with the appropriate serial number, any other device would not have access to play the encrypted data. Thus only users connected to the access device having the serial number would be able to play the encrypted data.*

Howard discloses wherein the access device is a network device for data transmission used in the network (Fig 1 and p1, paragraph 14), the access device serving to selectively download data from and upload data to the network (p4, paragraph 42 and p7, paragraph 74), wherein in the encrypting step c) the data is an electronic book and in the connecting step a) the access device is a personal digital assistant (PDA) or mobile phone (p3, paragraph 33) having an electronic book player function for playing the contents of the electronic book (p1-2, paragraph 15 and p5, paragraph 49).

Note that the examiner has interpreted the access device/electronic book player as the combination of a client computer and the limited-use web browser running on the client computer. One of ordinary skill should appreciate that the limited-use web browser disclosed by Howard is merely software and it would need hardware, i.e. a computer, such as items 121 and 125 seen in Fig 1, to enable functionality of the browser. One of ordinary skill should appreciate that because the computer running

Howard's limited-use browser is capable of displaying text and providing audio output, it inherently can either display the text of a book or play the audio recording of someone reading a book. Howard also disclosed that the client computer is a mobile phone (paragraph 33).

Claim Rejections - 35 USC § 103

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Howard et al (US 2002/0069365) in view of Candelore (US 6,697,489).

Claim 12:

Howard discloses:

a) Connecting an access device to a subscriber's end of a network (Fig 1 and p3, paragraph 31).

b) Providing a serial number in the access device to the network and using the serial number as an encryption key (p6, paragraph 61 and p7, paragraph 74). *Note that the limited-use browser is software running on the client, thus the serial number of the browser is located in the access device/client.*

c) Encrypting the data on the network to create encrypted data (p6-7, paragraph 69 and p7, paragraph 74).

d) Downloading the encrypted data only to the access device having the serial number (p7, paragraph 74).

e) Preventing users not connected to the access device having the serial number from receiving the encrypted data (p4, paragraph 42 and p7, paragraph 74). *One*

skilled should appreciate that because the data is prevented from being copied or saved to any other device except the device with the limited-use browser with the appropriate serial number, any other device would not have access to play the encrypted data. Thus only users connected to the access device having the serial number would be able to play the encrypted data.

Howard discloses wherein the access device is a network connecting device for data transmission used in the network (Fig 1 and p1, paragraph 14), the access device serving to selectively download data from and upload data to the network (p4, paragraph 42 and p7, paragraph 74), wherein in the encrypting step c) the data is audio data and in the connecting step a) the access device is a personal digital assistant (PDA) or mobile phone (p3, paragraph 33) having audio playing function for playing the audio data (p1-2, paragraph 15 and p4, paragraph 40).

Howard does not disclose the audio data being music data and the audio player being an MP3 player. However, it should be appreciated by one of ordinary skill that any device capable of playing audio data is capable of playing music since music is a type of audio. Further, Candelore discloses MP3-formatted audio files and MP3 recorders being well known in the art at the time applicant's invention was made (col 1, lines 23-44). It should be appreciated that if there are MP3 recorders that there would be devices which could play MP3 files.

At the time applicant's invention was made, it would have been obvious to one of ordinary skill in the art to modify Howard's invention in light of Candelore's teachings

according to the limitations recited in claim 12 such that the audio player was an MP3 player which plays MP3 formatted music data files. One of ordinary skill would have been motivated to do so because MP3 was a popular audio format at the time applicant's invention was made since it offered near CD quality music with relatively small file sizes. One of ordinary skill would also be motivated to do so because MP3 was a popular audio format and many web browsers at the time applicant's invention was made supported MP3 file formats.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ponnoreay Pich whose telephone number is 571-272-7962. The examiner can normally be reached on 9:00am-4:30pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ponnoreay Pich
Examiner
Art Unit 2135

PP

KIM VU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100